

REMARKS

By this amendment, claims 1-14 are pending, in which no claims are canceled, withdrawn from consideration, currently amended, or newly presented. No new matter is introduced.

The final Office Action mailed August 11, 2008 rejected claims 1-14 under 35 U.S.C. § 112, first and second paragraphs, and claims 1-14 under 35 U.S.C. § 102(e) as anticipated by *Harris et al.* (US 6,813,477).

At the outset, Applicants gratefully acknowledge the withdrawal of the objection to the drawings.

Applicants traverse the rejections of claims 1-14 under both 35 U.S.C. § 112 and 35 U.S.C. § 102(e).

Regarding the rejection under the first paragraph of 35 U.S.C. § 112, the Final Office Action states that claims 1-14 fail to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. In particular, the Final Office Action contends that the claim feature, “the stress to which the mobile-telephone under test is subjected is influenced in a targeted manner the number of transmission blocks of a multi-block” in claims 1 and 9 is not enabled because the “specification fails to properly describe how a person of ordinary skill in the art can determine the amount of stress on the mobile-telephone device under test based on some targeted manner” (Final Office Action-page 3).

To comply with the enablement clause of the first paragraph of 35 U.S.C. 112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. *In Re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973); *In re Gay*, 50 CCPA 725, 309 F.2d 769, 135 USPQ 311 (1962). If the examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the appellant to come forward

with evidence to rebut this challenge. *In re Doyle*, 482 F.2d 1385, 179 USPQ 227 (CCPA 1973); *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 58 CCPA 1207, 442 F.2d 985, 169 USPQ 723 (1971). However, the burden was initially upon the examiner to establish a reasonable basis for questioning the adequacy of the disclosure. *In re Strahilevitz*, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982), *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976); *In re Armbruster*, 512 F.2d 676, 185 USPQ 152 (CCPA 1975).

The Examiner's attention is respectfully directed to page, 5, lines 4-15, of the specification. Therein, is described that a particularly large stress in a mobile telephone device is induced by evaluating data in a transmission block if all of the transmission blocks transmitted contain an address signal ADR, which addresses the mobile-telephone device under test. As further described in that paragraph, one way to limit the stress is to specify the number of transmission blocks that address the mobile-telephone device, i.e., stress is reduced if the number of transmission blocks addressing the mobile-telephone device is reduced. This variable specification of the number of transmission blocks with the address signal ADR, addressing the mobile-telephone device under test, enables the stress of the mobile-telephone device under test to be "influenced in a targeted manner," i.e., the tester can "influence" the stress by changing the number of transmission blocks addressing the mobile-telephone device under test.

Accordingly, since this portion of the specification clearly enables any one of ordinary skill in the art to make and use the claimed subject matter by targeting the amount of stress on the mobile-telephone device under test through altering the number of transmission blocks, the Examiner has failed to establish a reasonable basis for questioning the adequacy of the disclosure. Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-14 under 35 U.S.C. § 112, first paragraph.

Regarding the rejection under the second paragraph of 35 U.S.C. § 112, the Final Office Action states that claims 1-14 are indefinite because “it is unclear whether the limitations following the phrases “in a manner such” and “targeted manner” are part of the claimed invention. Furthermore, it is not clear how stressing the mobile-telephone under test is influenced in a targeted manner the number of transmission blocks of a multi-block” (Final Office Action-page 4).

The Examiner is again respectfully directed to, e.g., page, 5, lines 4-15, of the specification. It is clear from this portion of the specification that the limitations following the phrases, “in a manner such” and “targeted manner,” are “part of the claimed invention.” MPEP §2173.02 cautions that “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. It is well settled that the claims define the invention, and all words within the claim must be considered when analyzing the metes and bounds of the claims. More specifically, it is very clear, for the reasons above, as to how stressing of the mobile-telephone device under test is influenced in a targeted manner. That is, the stress is determined by specifying the number of transmission blocks with the address signal ADR. Therefore, the stressing of the device under test is reduced (or “influenced in a targeted manner”) by reducing the number of transmission blocks addressing the device under test and the stressing of the device under test is increased (or “influenced in a targeted manner”) by increasing the number of transmission blocks addressing the device under test.

Accordingly, the claims are not indefinite and the Examiner is respectfully requested to withdraw the rejection of claims 1-14 under 35 U.S.C. § 112, second paragraph.

With regard to the rejection of claims 1-14 under 35 U.S.C. § 102(e), Applicants respectfully traverse this rejection because *Harris et al.* does not anticipate the instant claimed

subject matter. *Harris et al.* does teach the testing of a device and the determination of an error rate (e.g., see claim 12 of *Harris et al.*). However, *Harris et al.* lacks any teaching of determining an error rate “based on the number of incorrectly-evaluated transmission blocks,” wherein the number of transmission blocks of multiblocks, which address the device under test, is a number of transmission blocks of multiblocks “**specified in a manner such that the stress to which the mobile-telephone under test is subjected is influenced in a targeted manner between one transmission block per multiblock and all of the transmission blocks of the multiblock, wherein a multiblock includes a fixed number of transmission blocks,**” as in claim 1. *Harris et al.* also lacks a teaching of similar features in claim 9.

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The Final Office Action, at pages 4-6, discusses determining an error rate in a data transmission in accordance with the teachings of *Harris et al.* Also, the Action describes transmitting an excitation signal to the unit under test equal to the test signal 315 added to the interference signal 335 and it discusses comparing received information on a received result signal 360 to the original information on the test signal 315 to determine if a test is successful. The Final Office Action further discusses subdividing a test band to locate the frequency or frequencies causing the error. Conspicuously, the Final Office Action lacks any indication of a teaching in *Harris et al.* of a number of transmission blocks “**specified in a manner such that the stress to which the mobile-telephone under test is subjected is influenced in a targeted**

manner between one transmission block per multiblock and all of the transmission blocks of the multiblock, wherein a multiblock includes a fixed number of transmission blocks.” *Harris et al.* is absolutely silent on this claimed feature.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1-14 under 35 U.S.C. § 102(e).

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

October 7, 2008
Date

/Phouphanomketh Ditthavong/
Phouphanomketh Ditthavong
Attorney/Agent for Applicant(s)
Reg. No. 44658

Errol A. Krass
Attorney/Agent for Applicant(s)
Reg. No. 60090

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9952
Fax. (703) 519-9958